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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,955	07/20/2001	Stephen F. Dull	12587-020001	2457

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EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/909,955	<b>Applicant(s)</b> DULL ET AL.	
	<b>Examiner</b> Romain Jeanty	<b>Art Unit</b> 3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 10-12, 17-20, 27, 31 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-16, 21-26, 28-30, 32-54, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Final Office Action is in response to the communication received February 21, 2006. Claims 1-9, 13-16, 21-26, 28-30, 32-54, and 56-67 are pending in the application.

### **Response to Amendment**

2. Amendment to claims 16 and 21 has overcome the 35 U.S.C. 112, second paragraph rejection. The rejection is withdrawn.

### **Response to Arguments**

3. Applicant's arguments filed on February 21, 2006 have been fully considered but they are not persuasive.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-9, 13-16, 45, 47, 48, 50, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over David (Wo9959096) in view of Frost (U.S. Patent No. 5,041,972) and further in view of (A Review Of Conjoint Analysis) as set forth in the last Office action mailed on October 18, 2005.

6. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over David (Wo9959096) in view of Frost (U.S. Patent No. 5,041,972), in view of Revashetti et al (U.S. Patent No. 6,453,347) as set forth in the last office mailed on October 18, 2005.

7. Claims 39, 44 and 49 are rejected under 35 U.S.C. 103 (a) as being unpatentable over David in view of Frost as applied to claims 1, 8, and 15 above and further in view of Poiesz (Individual reactions to advertising: theoretical and methodological development) as set forth in the last office mailed on October 18, 2005.

8. Claims 41, 46, 51-54, and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over David in view of Frost, in view of as applied to claims 1, 8, and 15 above and further in view of Paul et al (Individual Hybrid Models for Conjoint Analysis) as set forth in the last office mailed on October 18, 2005.

### **Remarks**

9. Applicants asserted that David, DSS-Research Publication, and Frost fail to teach the claimed invention. Applicants further supported their assertion by arguing that the combination of David, DSS Research Publication and Frost does not teach the use of conjoint survey data to produce marketing analytics. Applicants further argued that there is no motivation to combine the three references.

In response, even if the references in the instant case do not expressly suggest the specific combination claimed by the inventor, an assertion which the examiner contests, the courts have stated "to support [a] conclusion that claimed combination is directed to obvious subject matter, references must either expressly or impliedly suggest claimed combination or examiner must present convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of references' teachings." *Ex parte Clapp*, 227 USPQ 972, 973 (BdPatApp&Int 1985). Furthermore, The Courts have already established that "[h]aving established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'" *In re Bozek*, 163 USPQ 545, 549 (CCPA 1969). In the instant case, combining David, Frost and DSS Research Publication would allow a user to measure market's sensibility to pricing changes.

In addition, the concept of using conjoint survey data to perform marketing analysis is notoriously old and well known in the marketing art. For example, Pinnell (Multistage Conjoint Methods to Measure Price Sensibility) teaches such well-known method.

In response to applicant's argument concerning impermissible hindsight, examiner asserts that "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper." *In re McLaughlin*, 170 USPQ

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209, 212 (CCPA 1971). In the instant case, combining David, Frost and DSS Research Publication would allow a user to measure market's sensibility to pricing changes.

Applicants further argued that Paul fails to teach or suggest processing at least the conjoint survey data to produce marketing analytics including calculating a total utility analytic based on the conjoint survey data. Received from multiple respondents. In response, the examiner respectfully disagrees with applicants because since the combined references of David, Frost, and the DSS Publication teaches the concept of collecting survey responses and processing the responses, and Paul in the same field of endeavor, teaches a utility measurement comprising a total utility analytic, it would have been obvious to a person of ordinary skill in the art to modify the disclosures of David, Frost and DSS Publication in order to calculate the brands that are likely to be purchased by consumers. Again, applicant is directed to the teachings of Pinnell (Pinnell (Multistage Conjoint Methods to Measure Price Sensibility) for this well-known teaching.

Applicants further argued on page 14 that the examiner fails to provide support for his position regarding the receipt of data in real time and applicants request that the examiner provide support for this position. In response, the examiner's support is found on page 3 of Ken (Individual level discrete-choice conjoint using CBC/HB).

Applicants further argued on page 15 that the examiner fails to provide support for his position for receiving conjoint survey data based on questions that have been adapted based on previous questions, and requested that the examiner provide documentary support for the rejection. In response, the examiner's support is found on pages 1-3 of Richard (Traveler preferences for information center attributes and services)

### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Thomas L. Pilon (Extensions to the Analysis of Choice Studies) which teaches receiving conjoint survey data.
- b. Dick et al (Commercial Use of Conjoint Analysis in Europe: Results and Critical Reflections) which teaches the concept of conjoint analysis.
- c. Joel (Conjoint Analysis: How We Got Here and Where We Are (An Update)) discloses the concept of conjoint analysis.
- d. Pinnell (Multistage Conjoint Methods to Measure Price Sensitivity) teaches conjoint analysis for research involving product design.
- e. Richard (Traveler preferences for information center attributes and services.
- f. Ken (Individual level discrete-choice conjoint using CBC/HB.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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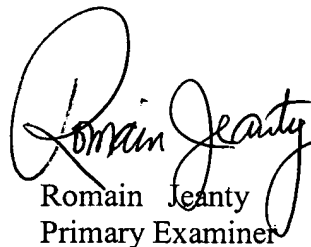
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 15, 2006

  
Romain Jeanty  
Primary Examiner  
Art Unit 3623